

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of )  
MICHAEL S. BOTTOM ET AL. ) Art Unit: 3617  
Application No. 10/082,752 ) Examiner: Jason B. Bellinger  
Filed: February 25, 2002 ) Paper No.: 6  
For: JOINT ASSEMBLY TO RESIST )  
GALLING )  
Attorney Docket No. 99-431.1 )  
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)

Peoria, Illinois 61629-6490

February 9, 2004

Mail Stop Non Fee Amendment  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION AND  
TERMINAL DISCLAIMER TO OBVIATE A DOUBLE  
PATENTING REJECTION UNDER 35 C.F.R. 1.321(c)

Sir:

I, Diana L. Charlton, represent that I am the attorney of record for this invention.

Your petitioner, Caterpillar Inc., having a place of business at 100 N.E. Adams Street, Peoria, Illinois of the United States of America, represents that it is the Assignee of the entire right, title, and interest to Application Serial No. 10/082,752, filed on the 25<sup>th</sup> day of February, 2002 for a Joint Assembly to Resist Galling recorded at reel 012957, frame 0411 (Continuation In Part of 09/642,676). The evidentiary material has been reviewed and Petitioner hereby certifies that, to the best of its knowledge and belief, title belongs to

Assignee.

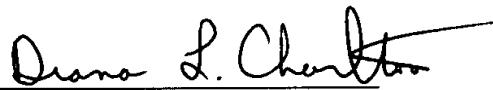
Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173 of the patent (U.S. Patent No. 6,485,116 B1) granted on Application Serial No. 09/642,676 as shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to commonly owned Application Serial No. 09/642,676 (U.S. Patent No. 6,485,116 B1), this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on the above-identified application that would extend to the expiration date of the full statutory term defined in 35 U.S.C. § 154 to 156 and 173 of the patent granted on Application Serial No. 09/642,676 (U.S. Patent No. 6,485,116 B1), in the event that said Application Serial No. 09/642,676 (U.S. Patent No. 6,485,116 B1) later: expires for failure to pay a maintenance fee, is held unenforceable or is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims cancelled by a reexamination certificate, is reissued in any matter or terminated prior to the expiration of the full statutory term as shortened by any terminal disclaimer, except for the separation of legal title stated above.

Petitioner has considered the art made of record by the Examiner, and believes that this terminal disclaimer places the application in condition for allowance.

Please charge the applicable statutory fee for a large entity for this terminal disclaimer to Deposit Account 03-1129. A duplicate copy of this terminal disclaimer is attached herewith.

Respectfully submitted,

  
Diana L. Charlton  
Diana L. Charlton  
Registration No. 36,103  
Caterpillar Inc.

Enclosures

DLC:vlm

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